REMARKS

This present case involves claims that were rejected during prosecution of the current application. Applicants ultimately appealed the rejections of the claims in the present application and received a Decision On Appeal dated June 16, 2008 (hereafter, 'the Board Decision'). In this decision, the Board of Patent Appeals and Interferences (hereafter, 'the Board') affirmed all prior rejections. The following is a summary of the grounds of rejection set forth by the Board:

- Claims 1, 4-8, 11-15, and 18-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer, et al. (U.S. Patent No. 6,092,114) (hereafter 'Shaffer').
- Claims 2, 3, 9, 10, 16, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer in view Schwalm, et al. (U.S. Patent No. 5,339,361) (hereafter 'Schwalm').

Applicants present the following remarks indicating that the amended claims of the present application are in condition for allowance.

Amendments to the Claims

In an effort to the move this case forward, Applicants amend claims 1, 8, and 15 in this Response. Applicants amend claims 1, 8, and 15 to include the limitation "wherein the email display capability status record for the domain includes: a display capability identification; a display capability description; a connection type, wherein the connection type is an indication of the protocol or communications technology to be used to send an email or digital objects to client devices; a connection address, wherein the connection address is an indication of where to send email or digital objects from the transcoding gateway; a transcode type, wherein the transcode type is an indication whether digital objects in email are to be transcoded in the transcoding gateway or forwarded for further processing elsewhere; an availability field, wherein the availability field is a status indication of whether a display capability is currently available to receive email or to

display digital objects included in email, including indicating whether a client device or display device is powered off or on; a recent usage field, wherein the recent usage field is a status indication of a recent time when a capability was used." Support for these amendments is found in Applicants' original specification at page 43, lines 1-28. Applicants submit that these amendments do not introduce any new matter into the specification and submit that the claims as currently amended are in condition for allowance.

Claim Rejections - 35 U.S.C. § 103 Over Shaffer

The Office Action rejects claims 1, 4-8, 11-15, and 18-21 for obviousness under 35 U.S.C. § 103 as being unpatentable over Shaffer. The question of whether Applicants' remaining claims are obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject Applicants claims for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a prima facie case of obviousness, Shaffer must teach or suggest all of Applicants' claim limitations. *Manual of Patent Examining Procedure* § 2142 (citing *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974)). Independent claim 1 as amended in this Response recites:

    1.   A method of email administration comprising the steps of:

        receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain;

receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification;

finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain includes:

a display capability identification;

a display capability description;

a connection type, wherein the connection type is an indication of the protocol or communications technology to be used to send an email or digital objects to client devices;

a connection address, wherein the connection address is an indication of where to send email or digital objects from the transcoding gateway;

a transcode type, wherein the transcode type is an indication whether digital objects in email are to be transcoded in the transcoding gateway or forwarded for further processing elsewhere;

an availability field, wherein the availability field is a status indication of whether a display capability is currently available to receive email or to display digital objects included in email, including indicating whether a client device or display device is powered off or on; and

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a recent usage field, wherein the recent usage field is a status indication of a recent time when a capability was used; and

sending at least one of the email display capability status attributes to the sender.

As discussed in more detail below, Shaffer does not teach or suggest each and every element and limitation of Applicants' claims. Shaffer therefore cannot be used to establish a prima facie case of obviousness against the claims of the present application.

Shaffer Does Not Teach Or Suggest A Display Capability Status Record For The Domain As Claimed In The Present Application

Claim 1 of the present application is amended to include the following limitations previously found in Applicants' original specification: finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain includes: a display capability identification; a display capability description; a connection type, wherein the connection type is an indication of the protocol or communications technology to be used to send an email or digital objects to client devices; a connection address, wherein the connection address is an indication of where to send email or digital objects from the transcoding gateway; a transcode type, wherein the transcode type is an indication whether digital objects in email are to be transcoded in the transcoding gateway or forwarded for further processing elsewhere; an availability field, wherein the availability field is a status indication of whether a display capability is currently available to receive email or to display digital objects included in email, including indicating whether a client device or display device is powered off or on; and a recent usage field, wherein the recent usage field is a status indication of a recent time when a capability was used.

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In rejecting claim 1 of the present application, the Final Office Action dated March 21, 2006, relies on Shaffer at column 6, line 6 – column 7, line 38, as teaching or suggesting "finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes." The Decision on Appeal in the present case affirmed this rejection. Applicants respectfully note in response, however, that this limitation has been amended in this Response to include limitations not found at the cited reference point, or any other reference points, in Shaffer.

The cited reference point in Shaffer merely discloses that an electronic message is transmitted from a client device to a local server that subsequently stores the message in memory of the local server. Shaffer then discloses that the file format of an attachment to the electronic message is identified at the server level, and that the access capabilities of the target client device are determined. After determining the access capabilities of the target client device, Shaffer discloses that it is then determined whether the attachment is accessible at the target client device without conversion. If the attachment is accessible without conversion, the message is transmitted to the target client at step. Optionally, if it is determined that the attachment is inaccessible without conversion, the message may nevertheless be transmitted to the client, if there is a determination that the conversion is neither complex nor time consuming. Shaffer further discloses that if it is determined that there is an incompatibility between the access requirements of the attachment and the direct access capabilities of the target client device, a determination is made regarding whether the attachment can be converted by the local server. If the attachment is locally convertible, the file-format change using known techniques is implemented and the message is made accessible to the target client device. Shaffer also discloses that if the attachment cannot be converted at the local server, a request to convert the attachment is generated and transmitted from the local server to the sending remote router/server.

Shaffer's method for delivering an attachment contained in an email message to a client device, however, does not teach or suggest finding, in dependence upon the domain

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identification, at least one email display capability status record for the domain as claimed in the present application. The claims of the present application have been amended to explicitly recite specific email display status attributes that must be contained in an email display capability status record for each domain. In contrast to the claims of the present application, Shaffer does not disclose an email display capability status record for each domain as claimed in the present application – an email display capability status record which includes a display capability identification, a display capability description, a connection type, a connection address, a transcode type, an availability field, and a recent usage field. As such, Shaffer cannot reasonably be said to teach or suggest each and every element and limitation recited in claim 1 of the present application. Because Shaffer does not teach or suggest each and every element and limitation recited in claim 1 of the present application, Shaffer cannot be used to establish a prima facie case of obviousness. The rejection of claim 1 under 35 U.S.C. § 103 should therefore be withdrawn and claim 1 should be allowed.

Relations Among Claims

Claims 8 and 15 recited a system and computer program product for email administration that each correspond to the method of claim 1. For the same reasons that Shaffer does not teach or suggest each and every element and limitation of claim 1, Shaffer also does not teach or suggest each and every element and limitation of claims 8 and 15 as amended in the present application. The rejection of claims 8 and 15 should therefore be withdrawn and the claims should be allowed.

Claims 4-7, 11-14, and 18-21 depend from independent claims 1, 8, and 15 of the present application. Each dependent claim includes each and every element and limitation recited in the claim from which it depends. For the same reasons that Shaffer does not teach or suggest every element and limitation of independent claims 1, 8, and 15, Shaffer also does not teach or suggest every element and limitation of dependent claims 4-7, 11-14, and 18-21. The rejection of claims 4-7, 11-14, and 18-21 should therefore be withdrawn and the claims should be allowed.

Claim Rejections – 35 U.S.C. § 103 Over Shaffer And Schwalm

Claims 2, 3, 9, 10, 16, and 17 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Shaffer in view of Schwalm. To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 2, 3, 9, 10, 16, and 17. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claims 2, 3, 9, 10, 16, and 17 depend respectively from independent claims 1, 8, and 15 and include all the limitations of the independent claims from which they depend. In rejecting dependent claims 2, 3, 9, 10, 16, and 17, the Office Action relies on Shaffer as teaching or suggesting each and every element of independent claims 1, 8, and 15. As shown above, Shaffer in fact does not teach or suggest each and every element of independent claims 1, 8, and 15. Because Shaffer does not teach or suggest each and every element of independent claims 1, 8, and 15, the combination of Shaffer and Schwalm cannot possibly teach or suggest each and every element of dependent claims 2, 3, 9, 10, 16, and 17. The proposed combination of Shaffer and Schwalm, therefore, cannot establish a prima facie case of obviousness and the rejections 35 U.S.C. § 103(a) should be withdrawn.

Conclusion

Claims 1, 4-8, 11-15, and 18-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer. As shown above, Shaffer does not teach or suggest each and every element and limitation of the claims of the present application. Shaffer therefore cannot be used to establish a prima facie case of obviousness against Applicants' claims. The rejections under 35 U.S.C. § 103 should therefore be withdrawn and the claims should be allowed. Applicants respectfully request reconsideration of claims 1, 4-8, 11-15, and 18-21.

Claims 2, 3, 9, 10, 16, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer in view Schwalm. As shown above, the combination of Shaffer and Schwalm does not teach or suggest each and every element and limitation of the claims of the present application. The combination of Shaffer and Schwalm therefore cannot be

used to establish a prima facie case of obviousness against Applicants' claims. The rejections under 35 U.S.C. § 103 should therefore be withdrawn and the claims should be allowed. Applicants respectfully request reconsideration of claims 2, 3, 9, 10, 16, and 17.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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